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09/855,585	05/16/2001	Henry V. Izzo	2280.2720	1418

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EXAMINER
JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/855,585	IZZO ET AL.
	Examiner	Art Unit	
	Jean Janvier	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____ .

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5) ☐ Notice of Informal Patent Application (PTO-152)

    Paper No(s)/Mail Date _____ .   6) ☐ Other: _____ .

DETAILED ACTION

Claim Status

Claims 1-24 are currently pending in the Instant Application.

Specification

Claim Objections

Claims 2-7, 9-12, 14-17 and 19-24 are objected to because of the following

informalities-

Concerning claims 2-7, following independent claim1, dependent claims 2-7 should refer

to - -The method accords to claim xx...-- instead of "A method according to claim xx...".

Concerning claims 9-12, following independent claim 8, dependent claims 9-12 should

refer to   - -The server according to claim xx...-- instead of "A server according to claim

xx...".

Concerning claims 14-17, following independent claim 13, dependent claims 14-17

should refer to - -The computer readable medium according to claim xx...-- instead of " A

computer readable medium according to claim xx...".

Concerning claims 19-24, following independent claim 18, dependent claims 19-24

should refer to - -The apparatus according to claim xx...-- instead of " An apparatus according to

claim xx...".

Appropriate corrections are required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a)   A patent may not be obtained though the invention is not identically disclosed or

        described as set forth in section 102 of this title, if the differences between the

        subject matter sought to be patented and the prior art are such that the subject

        matter as a whole would have been obvious at the time the invention was made to

        a person having ordinary skill in the art to which said subject matter pertains.

        Patentability shall not be negatived by the manner in which the invention was

        made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cairns, USP

6,173, 267B1.

As per claims 1-2, 4-19 and 21-24, Cairns discloses a method of and a system for

providing fulfillment in a promotional contest, which includes the step of providing a card

in a product package marked with an Internet address and a password or contest code. A

purchaser of the product contacts the Internet address and inputs personal information

before entering the password or contest code into an Online prize redemption site (web

site) to learn if the purchaser is a winner in the contest following a validating process (for

determining if the entered code is valid-check/balance). If the purchaser is a winner, then

the card is sent to the company or promoter to verify (validate) the winning status, related

to the password or contest code inputted at the Internet prize redemption site, before

sending the prize to the purchaser (See abstract; figs 1-3; col. 1: 65 to col. 2: 54).

Each product 18 of fig. 2 in a production runs is provided with a card 12 of fig. 2. Each of

the cards 12 is provided with the Internet address 14 of fig. 2 and different codes 16 of fig. 2.

Here, each code or contest code or password is unique. The incorporation of the card 12 into the

product 18 packaging is accomplished by automated machinery, which mounts the card by an

adhesive, for example, on the product box or product container wherein it could be covered by

wrapping such as shrink wrap. The card 12 may be inserted into the package, such as into the

product box or may be under a label as well. Instead of placing the card 12 in or on the product

package, the card may be incorporated into the product package by being printed on the package,

printed as part of a label or on the back of a label. The product may be a product or service

catalog or advertisement and the card is provided in the catalog or advertisement, such as by

being inserted into the catalog or by being printed on a catalog page, for example (fig. 2; col. 3:

1-23).

In general, each product 18 of fig. 2 in a production runs is provided with a card 12 of fig.

2. Each of the cards 12 is provided with the Internet address 14 of fig. 2 and different codes 16 of

fig. 2. Here, each code or contest code or password is unique. The incorporation of the card 12

into the product 18 packaging is accomplished by automated machinery, which mounts the card

by an adhesive, for example, on the product box or product container wherein it could be covered

by wrapping such as shrink wrap. The card 12 may be inserted into the package, such as into the

product box or may be under a label as well. Instead of placing the card 12 in or on the product

package, the card may be incorporated into the product package by being printed on the package,

printed as part of a label or on the back of a label. The product may be a product or service

catalog or advertisement and the card is provided in the catalog or advertisement, such as by

being inserted into the catalog or by being printed on a catalog page, for example (fig. 2; col. 3:

1-23). **The card 12 is provided with the product 18 inside the packaging/package in such a**

way as to only be available to the purchaser or customer after the product is purchased and

the packaging is open. Ideally, the outside of the product package 18 includes information announcing the contest or sweepstakes and indicating that the card 12 or other playing piece is enclosed therein (notifying the potential purchaser of the presence of the card 12 related to the contest inside the product package-Col. 3: 24-40).

As shown in fig. 2, the card 12 has been marked with the Internet address 14 (identifier or code) for an Internet site, such as a world wide web site, at which is available custom developed web site for the contest or sweepstakes. The card has also been marked with the code or password 16 (contest code) or other information. The code 16 may be unique to each card 12, related to a product, or may be indicative of classes of applicants or customers, such as one code (contest code) for non-winning cards, inserted in a plurality of product packages, another code or contest code for a top level winner and other of winners of second tier or lower prizes (establishing one or more subsets of entrants or applicants or categorizing the applicants as non-winners, top-level winners, lower-prize winners, etc., based on the (type of) contest codes or passwords inserted in individual product packages and determining whether a contest code entered by a customer matches a pre-determined winning code as read from an associated list). Promotional information or other encoded information may also be marked on the card, including advertising, a discount coupon or other information (col. 3: 53-64; fig. 2).

Furthermore, for purchasers who have no access to the Internet address, an alternative may be provided wherein a purchaser returns the card by mail, for example. This enables all purchasers to participate in the sweepstakes, but is not preferred (col. 4: 4-22 and **23-27**).

After receiving the code 16 or contest code (password) and the entrant's or purchaser's personal information from the purchaser 24, prior to determining whether the entered contest code is a winning code, **the inputted code 16 is compared to a list of winning codes (passwords), related to the one or more established subsets or categorizing step, to determine whether that code is a winner at some prize level in accordance with the established one or more subsets or categorizing step**, as shown at step 60 of fig. 1. **Alternately, the code 16, which is input by the purchaser 24 may be subject to some computation, random selection, or other means for determining a winning or non-winning status, instead of the look-up list (a winner may be randomly determined). The purchaser 24 is then informed of his or her status based on the entered code 16 (contest code), in other words, whether the purchaser 24 has won some prize**, as shown at step 70 (col. 4: 47-57; fig. 1).

As per claims 1, 8, 13 and 18, although Cairns discloses a system wherein a card 12 having printed thereon a URL 14 and a code or contest code 16 and the card 12 is inserted inside the packaging of a product 18,   wherein the URL address is used by a purchaser or recipient of the product 18 as an interface to enter the contest code 16 and the contest code 16 may be unique to each card 12, related to a product, or may be indicative of classes of applicants or customers, such as one code (contest code) for non-winning cards, inserted in a plurality of product packages, another code or contest code for a top level winner and other of winners of second tier or lower prizes (establishing one or more subsets of entrants or applicants or categorizing the applicants as non-winners, top-level winners, lower-prize winners, etc., based on the (type of) contest codes inserted inside the individual product

packages and determining whether a contest code entered by a customer matches a pre-determined winning code as read from an associated list-col. 3: 53-64; fig. 2), however, Cairns does not expressly teach establishing a subset of items from a plurality of items and wherein each item of the subset including a winning code unique to the subset (determining whether a contest code inputted by a customer matches a winning code unique to a subset of the plurality of items).

However, the Examiner notes that the step of establishing a subset of items from a plurality of items and wherein each item of the subset including a winning code unique to the subset does not play any significant role in determining whether an inputted contest code related to a product matches a winning code from a list of winning codes stored in a system database. This determination is made in accordance with a number of pre-defined "winning" codes stored in the database regardless of whether or not a winning code is unique to a subset of items or a winning code is pre-printed on the related product or item. In other words, the step of establishing a subset of items from a plurality of items and wherein each item of the subset including a winning code unique to the subset or pre-printing a winning code on the featured item in addition to a contest code is a matter of desires, which does not directly impact the functionality or utility of the system or the step or system by which a consumer inputs the contest code related to the product/item and the step of determining if there is a match between the inputted contest code and a plurality of pre-determined winning codes stored in a database. Here, only the contest code related to the product is necessary for the system to function. **This is also a non-functional descriptive material.**

Thus, it would have been obvious to an ordinary skilled artisan, implementing the system of Cairns or the present invention, to reach the above conclusion at the time of the invention or realize that the step of establishing a subset of items from a plurality of items and wherein each item of the subset including a winning code unique to the subset or pre-printing a winning code on the featured item in addition to a contest code is a matter of desires or a matter of choice, which does not directly impact the functionality or utility of the system or the step or system by which a consumer inputs the contest code related to the product/item and the step of determining if there is a match between the inputted contest code and a plurality of pre-determined winning codes stored in a database and that only the contest code related to the product is necessary for the system to function.

As per claims 4, 5, 9, 10, 14, 15, 21 and 22 Cairns does not explicitly disclose that the step of establishing the subset occurs before the step of enabling the consumer to input the contest code or the step of establishing the subset occurs after the contest codes have been inputted.

However, the Examiner notes that establishing the subset before or after the consumer has inputted the contest code into a redemption system is a matter of choice or desires, which does not directly impact the functionality or utility of the system or the step or system by which a consumer inputs the contest code related to the product/item and the step of determining if there is a match between the inputted contest code and a plurality of pre-determined winning codes stored in a database. **This is also a non-functional descriptive material.**

Therefore, it would have been obvious to an ordinary skilled artisan, implementing the

system of Cairns or the present invention, to reach the above conclusion at the time of the

invention or realize that establishing the subset before or after the consumer has inputted the

contest code into a redemption system or redemption web site is a matter of choice or desires,

which does not directly impact the functionality or utility of the system or the step or system by

which a consumer inputs the contest code related to the product/item and the step of determining

if there is a match between the inputted contest code and a plurality of pre-determined winning

codes stored in a database.

As per claims 3 and 20, Cairns does not expressly disclose that the consumer inputs the

contest code via a kiosk (terminal).

However, it is common practice in the art for a consumer to enter a contest code via a

kiosk or an apparatus installed at a location (see US Patent 5,883,620 for more details). It is also

well documented in the art that a user can use a kiosk or a store terminal to request and select

coupons locally or remotely stored in a database.

"Official Notice"

Therefore, it would have been obvious to an ordinary skilled artisan at the time of the

invention to incorporate the above disclosure ("Official Notice") into the Cairns' system so as to

enable a consumer to input a contest code related to a product into a redemption system or

Internet site via a kiosk or a store terminal in order to determine if he is the winner of a prize,

thereby allowing the consumer to know in real-time, subsequent to acquiring or purchasing a

product or while at the POS, whether or not he has won a prize when his inputted contest code matches a contest code previously stored in the redemption system or Internet site database.

Response to Applicant's Arguments

Applicant's arguments with respect to the claimed invention have been considered, but are moot in view of the new ground(s) of rejection. In other words, the Applicant's are fully addressed in the above Action.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final.**

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,883,620 to Hobbs discloses an electronic prize-verification and display apparatus that provide an interactive interface with a consumer to receive information, such as an alphanumeric data sequence that includes a plurality of digits, indicative of a prize to be awarded to that consumer. The display apparatus compares the received alphanumeric data sequence with a predetermined series of winning sequences and displays a prize won by the consumer or a message encouraging the consumer to try again. The alphanumeric data sequence could be a prize code printed on a consumer product, such as a paper cup. Upon purchase of the product, a consumer would enter the prize code into the electronic prize verification and display apparatus

to determine if the prize code was a winning code, and if so, the prize won. To facilitate entry of

the prize code and display of an appropriate message to the consumer, the electronic prize

verification and display apparatus preferably includes a keypad and liquid crystal display. As

each digit of the alphanumeric data sequence is entered into the apparatus, it is displayed on the

liquid crystal display. Upon entry of a predetermined number of digits, or upon actuation of an

appropriate key by the consumer, the entered sequence is compared to the predetermined series

of winning sequences for verification (See abstract). **This is a very good reference under 35

USC 103(a).**

USP **5,007,641** to Seidman discloses a promotional game wherein prizes are

automatically awarded upon presentation of tokens bearing machine readable codes. The tokens

may be identical to tokens bearing a common code, and the prizes may be awarded at random to

patrons who present an appropriate token bearing this common code. Desirably, the prizes are

awarded substantially immediately upon presentation of the tokens. The tokens may be product

identification code symbols on packages of goods (See abstract).

USP 5,898,153AA to Lagan discloses a method for automatically processing sweepstakes

entries and mail orders is disclosed. The method reads a machine code identifying the sender and

simultaneously detects orders from non-orders using a magnetic field detector, without opening

the envelopes. The machine code is printed on the outside face of the envelope, or alternatively,

on the reply insert itself, in which case it is visible through a die-cut window formed in the return

envelope. When read, the machine code identifies the contestant and enters him or her into the

sweepstakes. The returned envelopes are also fed through a sorter, which magnetically detects

whether each return envelope contains a magnetic order stamp. If the sorter detects a magnetic

stamp, the envelope is routed to an order batch where the envelope is opened for order

processing; otherwise the envelope is routed to a non-order batch. During the outgoing mail

processing, a machine code indicative of the recipient may be preprinted on each carrier

envelope or reply insert. This code may be read and used to print a machine code corresponding

thereto on the return envelope. The return envelope and the reply insert, along with order stamps

each having a magnetic ink layer, are inserted into the carrier envelope and mailed out to the

recipient (See abstract).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to

Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally

be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached

at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft (effective on 7/15/05).

12/13/07   Jean D. Janvier

        JDJ   Patent Examiner

                                                           Art Unit 3622

**JEAN D. JANVIER
PRIMARY EXAMINER**